

REMARKS

Claims 1-17, 19-21 and 23 are pending in this application. By this Reply, Applicant has amended claims 1, 12, 17, 21 and 23. Accordingly, claims 1-17, 19-21 and 23 are at issue. Applicant respectfully submits no new matter was added by these amendments.

Applicant notes the objections to the drawings have been withdrawn. Applicant also notes the rejection of claims 1, 12, 17 and 21 under 35 U.S.C. 112, first paragraph was also withdrawn.

The Examiner has indicated that certain references submitted in Applicant's Information Disclosure Statement of September 28, 2004 were not considered because the Statement did not provide a concise statement of relevance of EP 0917034; DE 19615190; and FR 2785122. The only relevance known regarding these three references is that they were cited in the International Search Report for WO 01/69335 which was also included with the Information Disclosure Statement (as item "H"). The Examiner has indicated that the Search Report was considered. Applicant is submitting herewith a Supplemental Information Disclosure Statement with a statement of relevance (as explained herein) for the references. Accordingly, Applicant requests that the Examiner also consider the references identified above.

The Examiner has objected to claim 21 because of certain informalities. By this Reply Applicant has amended claim 21 to correct the informalities. Accordingly, Applicant respectfully submits this objection is now moot.

The Examiner has rejected claims 1, 2, 4-6, 8, 9, 12, 13, 15, 17, 19-21 and 23 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,909,368 by Nixon (in the Office Action, the Examiner transposed the last two numbers and mistakenly identified the Nixon patent as 5,909,386). Applicant respectfully traverses this rejection.

Claim 1 is directed to a control system having an automation device and a network device connected by a network. The network device stores a customized application program that

controls the automation device. As required by claim 1, “the customized application program is selected by the network device in response to an application program request message received at the network device and sent from the automation device as part of a bootstrap protocol.”

The system of Nixon does not disclose a control system in accordance with claim 1. The system of Nixon includes field devices, controllers coupled to the field devices and work stations coupled to the controllers. The work stations include a user interface for “providing display screens for enabling the user to select methods or programs that perform the new or modified function for the particular control template.” (See Nixon, col. 10, lines 13-32).

In contrast to the system of claim 1, the control program of Nixon is not selected in response to an application program request message received from the automation device. Instead, the control program of Nixon is generated “in response to user input commands.” (See e.g., Nixon, col. 7, lines 8-13, “Main PC 2 is configured to generate, in response to user input commands, various control routines that are provided via the ACN 3 to one or more local controllers identified as elements 4 and 5 which implement the control strategy defined by the control routines selected and established in main PC 2”). It is the user, through a workstation, not the controller itself (i.e., automation device) that requests a particular control routine to be downloaded to the controller.

This difference between the system of claim 1 and the system of Nixon is consistent with the stated problems discussed in Nixon. As set forth in the Background of the Invention of Nixon:

One problem associated with the use of graphical views for process control programming is that existing systems allow only the equipment manufacturer, not the user of this equipment, to create his own control functions, along with associated graphical views, or modify the predefined functions within the provided library. (Nixon, col. 3, line 42-48).

Nixon provides a system for allowing a user to select the control software. The control software

is not in response to a request from the automation device.

The Examiner cites to col. 28, lines 35-43 and Figure 17 of Nixon for the quoted limitation of claim 1. However, the steps of Figure 17 and the description at col. 28 do not specify that the control routine is selected by the network device in response to an application program request message sent by the automation device. Instead, step 1628 of Nixon, which downloads software to a controller, is performed after step 1626 which requires user interaction. Moreover, because the downloading to the controller in Nixon is done after some user interaction, it is not clear whether this is occurring at “a boot time” as also required by claim 1.

The claims of Nixon confirm the system is intended to allow a user (via a workstation) to select the program to be downloaded to a controller. (See e.g., claim 1 of Nixon, “. . . a workstation coupled to the controller, the workstation including a user interface; and a software system implementing a control strategy for the process control system, the control strategy being selectively implemented via the user interface. . . .”). In other words, the control routine is provided to the controller in response to commands by the user through the user interface of a workstation, as opposed to being in response to a request from the automation device as provided in claim 1 of the present invention.

Accordingly, because Nixon does not disclose each limitation of claim 1, Applicant respectfully submits Nixon does not anticipate claim 1. See *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984) (Anticipation is established only when a single prior art reference discloses each and every element of a claimed invention.). Claims 2, 4-6, 8 and 9 depend on claim 1, either directly or indirectly, and include each of its limitations. Accordingly, Applicant respectfully submits claims 2, 4-6, 8 and 9 are also patentable over Nixon.

Claim 12, as amended herein, is directed to a method of operating a control system. Claim 12 requires “transmitting a message for requesting a network address for the automation

device by the automation device; transmitting a message by the automation device for requesting the customized application program for the automation device as part of a bootstrap protocol;” and “selecting the customized application program in response to the message for requesting the customized application program.”

As set forth above, Nixon does not disclose a system wherein the control routine is in response to a request from the automation device. Instead, the user of the system requests the control routine through a workstation coupled to a controller. Accordingly, Applicant respectfully submits claim 12 is not anticipated by Nixon.

Claims 13 and 15 depend on claim 12 and include each of its limitations. Accordingly, Applicant respectfully submits claims 13 and 15 are also patentable over Nixon.

Claim 17 requires “means for transmitting a message requesting a network address by the automation device; means for transmitting a message by the automation device requesting the customized application program as part of a bootstrap protocol;” and “means for selecting the customized application program in response to the message requesting the customized application program.”

As set forth above, Nixon does not disclose the means of claim 17. Accordingly, Applicant respectfully submits claim 17 is not anticipated by Nixon.

Claims 19 and 20 depend on claim 17 and include each of its limitations. Accordingly, Applicant respectfully submits claims 19 and 20 are also patentable over Nixon.

Claim 21 requires “requesting the customized application program by the automation device as part of a bootstrap protocol.” As set forth above, Nixon does not disclose this limitation. Accordingly, Applicant respectfully submits claim 21 is patentable over Nixon.

Claim 23 depends on claim 21 and includes each of its limitations. Accordingly, Applicant respectfully submits claim 23 is patentable over Nixon.

The Examiner has rejected claims 3, 14 and 16 under 35 U.S.C. 103(a) as being

unpatentable over Nixon in view of Ditze. Applicant respectfully traverses this rejection.

Claim 3 indirectly depends on claim 1 and includes each of its limitations, and claims 14 and 16 depend on claim 12, either directly or indirectly, and include each of its limitations. As set forth above, Nixon fails to disclose each of the limitations of claims 1 or 12. Ditze does not cure these failures. Accordingly, for the reasons given above with respect to claims 1 and 12, Applicant respectfully submits claims 3, 14 and 16 are patentable over Nixon in view of Ditze.

Additionally, there is also no incentive or motivation in the prior art to make the combination proposed by the Examiner. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, there is absolutely no incentive in the cited references to combine the references in the manner suggested by the Examiner. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden on factually supporting

any *prima facie* conclusion of obviousness. See MPEP § 2142. In the present case, the Examiner failed to meet this burden and simply concludes it would have been obvious to combine the references.

It is apparent the Examiner took isolated features from the cited references, and has used the claims of the present application as a template. Such hindsight reconstruction is improper. It is well-recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 (“one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

The Examiner has rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Nixon in view of Stripf. Applicant respectfully traverses this rejection.

Claim 7 depends on claim 1 and includes each of its limitations. As set forth above, Nixon fails to disclose each of the limitations of claim 1. Stripf does not cure these failures. Accordingly, for the reasons given above with respect to claim 1, Applicant respectfully submits claim 7 is patentable over Nixon in view Stripf.

Additionally, the Examiner has again failed to show an incentive or motivation in the prior art to make the proposed combination.

The Examiner has rejected claim 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Nixon. Applicant respectfully traverses this rejection.

Claims 10 and 11 depends on claim 1 and includes each of its limitations. As set forth above, Nixon fails to disclose each of the limitations of claim 1. Accordingly, for the reasons given above with respect to claim 1, Applicant respectfully submits claims 10 and 11 are patentable over Nixon.

Additionally, the Examiner has again failed to show an incentive or motivation in the prior art to make the proposed modification to Nixon.

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CONCLUSION

In light of the foregoing reasons, Applicant respectfully requests reconsideration and allowance of claims 1-17, 19-21 and 23. The Commissioner is authorized to charge any additional fees or credit any overpayments associated with this Amendment to Deposit Account 23-0280. Applicant further invites the Examiner to contact the undersigned representative at the telephone number below to discuss any matters pertaining to the present Application.

Respectfully submitted,

Date: March 29, 2005

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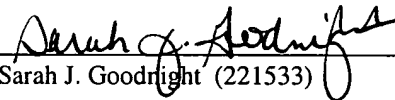
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP RCE, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on March 29, 2005.



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